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REMARKS

Claims 1-12 and 14-22 remain in the application. Claim 13 has been cancelled. Claims 3, 12, and 14 have been amended. No new matter has been introduced via these amendments.

Claim 3 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. As alluded to above, claim 3 has been amended. In view of the amendment to claim 3, the Applicant respectfully asserts that this § 112, second paragraph, rejection is overcome.

Claims 1-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jones et al. (United States Patent No. 5,833,893) in view of Scheibelhoffer et al. (United States Patent No. 5,670,561). Claims 12-21 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Blackburn et al. (United States Patent No. 4,089,699).

The Applicant respectfully asserts that the Examiner has not established the requisite *prima facie* case of obviousness and, therefore, traverses these rejections.

As the Examiner is likely aware, to appropriately establish a *prima facie* case of obviousness, three basis criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

§ 103(a) Rejection of Claims 1-22:

Relative to the first criterion, the teaching or suggestion to make the claimed combination must be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d

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488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Furthermore, as the Examiner is also aware, precedential cases such as *In re Sang Su Lee* (277 F.2d 1338), *In re Zurko* (258 F.3d 1379), and *W.L. Gore v. Garlock, Inc.* (721 F.2d 1540) require that the Examiner refrain from overly conclusory statements when making an argument to modify a reference or motivation to combine references. *Gore* specifically recognizes that it is improper, in determining whether a person of ordinary skill would have been led to a modification of a particular reference, simply to "[use] that which the inventor taught against its teacher." Furthermore, on June 9, 2005, the Court of Appeals for the Federal Circuit upheld *In re Sang Su Lee* and reasserted the rule that obviousness requires proof of a motivation or suggestion to combine elements of the invention (see *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, Fed. Cir., No. 04-1493, 6/9/05).

Simply stated, there is no motivation to combine the teachings of Jones et al. and Scheibelhoffer et al. Therefore, the first criterion is not satisfied. In fact, it can even be argued that Scheibelhoffer et al. actually teaches away from Jones et al.

On Page 4 of the Office Action, the Examiner indicates that Jones et al. equates vinyl copolymer dispersants to the "exemplified polyesters" such as LB-100. This is not the case. In fact, a complete review of Jones et al. makes it clear that Jones et al. never equates these two chemical components. From this review, water soluble/dispersible polyesters and water soluble/dispersible vinyl polymers and copolymers can be used as suitable dispersants. However, nowhere does Jones et al. equate these two chemical components as the Examiner contends. Merely because two chemical components can be used as a suitable dispersant, this does not arise to an equivalence between the two chemical components. In fact, by including such an extensive list of useful dispersants, one could reasonably argue that Jones et al. recognizes that all the various possible dispersants are, in fact, not equivalent.

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More importantly, there is also no motivation to combine Jones et al. with Scheibelhoffer et al. or Scheibelhoffer et al. with Jones et al. because Scheibelhoffer et al. actually teaches away from Jones et al. and is, therefore, not appropriately combinable with Jones et al. Independent claim 1 positively recites that an aqueous dispersion is formed and that this aqueous dispersion contain the additive and the dispersing agent. Jones et al. does disclose water dispersible dispersants, i.e., dispersing agents. However, Scheibelhoffer et al. must be considered as a whole and referring specifically to column 9, lines 37-44, it is clear that the "color concentrate" of Scheibelhoffer et al. is essentially, if not entirely, a water-free system. Furthermore, no where else throughout its disclosure does Scheibelhoffer et al. disclose, teach, or suggest dispersing agents that are present in an aqueous dispersion.

In view of clarifying remarks set forth above, it is apparent that no appropriate *prima facie* case of obviousness has been established against claims 1-11. Furthermore, because Scheibelhoffer et al. and Jones et al. are not properly combinable, there is no combination of record that renders claims 12-22 obvious, especially in view of claim 12 in its amended form.

§ 103(a) Rejection of Claims 12-21:

Relative to the rejection of original dependent claim 13 (the substance of which has now been incorporated into amended independent claim 12), the Examiner concludes, in a highly conclusory fashion, that "[t]he proportions are encompassed by Applicant's claims" (*refer to Page 5 of the Office Action*). To the contrary, Blackburn does not disclose, teach, or otherwise suggest, all of the precise wt% amounts claimed in amended independent claim 12. A thorough review of all of the examples of Blackburn confirms that all of the claimed wt% amounts are not disclosed or taught by Blackburn. Furthermore, there are no explicit motivations contained within Blackburn to modify its disclosure to arrive at the precise claimed wt%s. Thus,

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independent claim 12, as amended, is also allowable over the § 103(a) rejection relying on Blackburn.

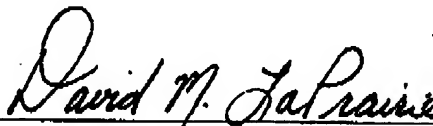
In view of the amendments to the claims and the remarks set forth above relative to independent claims 1 and 12 (as amended), no appropriate *prima facie* case of obviousness has been established. Thus, it is respectfully submitted that independent claims 1 and 12 are allowable. Furthermore, the remaining claims depend either directly or indirectly from the non-obvious features of claims 1 and 12 such that the dependent claims are also allowable.

It is respectfully submitted that the Application is now presented in condition for allowance, which allowance is respectfully solicited.

No fees are believed to be due. However, if necessary, the Commissioner is authorized to charge Deposit Account No. 08-2789 for any additional fees or to credit the account for any overpayment.

Respectfully submitted,
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